

REMARKS

Claims 1-24 were originally filed in this case. Claim 5 has been canceled without prejudice. Accordingly, claims 1-4 and 6-24 are pending and under examination.

35 U.S.C. § 103(a)

Claims 1-4 and 6-24 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Suzuki, et al., U.S. Patent 5,219,560 ("Suzuki"). (Paper No. 20080910 at 3.) Applicant respectfully traverses. Applicant has discovered that the claimed cosmetic compositions containing the claimed polymer dispersions exhibit unexpectedly better transfer resistance compared to the cosmetic compositions disclosed in Suzuki. It is submitted that the results in the accompanying Declarations under 37 C.F.R. § 1.132 of Bertrand Lion ("Lion Declaration") and Pascal Arnaud ("Araund Declaration") establish that the claimed invention is nonobvious and patentable.

More specifically, in making the rejection, the Examiner has alleged that Suzuki teaches "a cosmetic composition comprising a acryl-silicone graft copolymer prepared by i) a dimethylpolysiloxane compound with polymerizable radical group on one of the terminal ends and ii) a radically polymerizable monomer comprising as major components acrylate and/or methacrylate and including various other monomers such as (meth)acrylic acid" (Paper No. 20080910 at 3.) The Examiner further alleged that Suzuki teaches that "the copolymer is combined with a low-viscosity silicone oil like dimethylpolysiloxane to form a stable composition" (*Id.*)

Suzuki's examples illustrate 6 embodiments of the graft copolymers of his invention. All 6 of these copolymers are made from the polymerization of a dimethylpolysiloxane having a methacrylate group, methylmethacrylate, and one or more additional components. (Reference Examples 1-5 (col. 16, line

54 - col. 18, line 38) and Example 3 (col. 18, line 62 - col. 19, line 19.) None of the additional components in these 6 embodiments, however, is acrylic acid or methacrylic acid. In short, *Suzuki* does not teach any specific grafted copolymer including acrylic acid or methacrylic acid, as claimed.

Thus, *Suzuki* does not exemplify any polymer with a skeleton including acrylic acid or methacrylic acid, as claimed. In column 3, lines 50-61, *Suzuki* teaches that the radically polymerizable monomers that make up the skeleton of its graft copolymers upon polymerization, have acrylate or methacrylate, or both as its major component. The list does not include the acid counterparts thereof, i.e., acrylic acid and methacrylic acid. In column 4, lines 1-9, *Suzuki* teaches that other components **may be** included in the radically polymerizable monomer, including (meth)acrylic acid, as **clearly optional ingredients**. This is consistent with all of *Suzuki's* examples, none of which show the use of (meth)acrylic acid.

The claimed cosmetic compositions include the claimed dispersions of polymer particles in a non-aqueous, silicone medium. The polymer particles have a skeleton made from a first C₁-C₃ alkyl (meth)acrylate monomer, alone or as a mixture of C₁-C₃ alkyl (meth)acrylate monomers, and acrylic acid and/or methacrylic acid, and side chains made from a silicone macromonomer.

In the accompanying Declaration of Pascal Arnaud, a claimed cosmetic composition containing the claimed polymer dispersion was compared to a cosmetic composition in accordance with *Suzuki*, i.e., the comparative cosmetic composition included a graft copolymer made from the polymerization of a dimethylsiloxane and methyl acrylate. (Pascal Declaration, ¶ 4 and Lion Declaration, ¶¶ 3-5.) Therefore, the evidence in the Pascal Declaration is a result of a direct comparison of the invention and the closest prior art of record.

Transfer resistance, as described in the Pascal Declaration, is a measure of the ability of a substance to remain on the substrate to which it is applied when the substrate is brought into contact with another surface. (¶ 8.) In cosmetics, for example, an increased transfer resistance means that a composition is more likely to remain on the skin to which it is applied when the skin is contacted with, for example, clothing or other skin, e.g., face to hand contact.

As explained in the Pascal Declaration, the claimed cosmetic composition was found to exhibit 7-times better results than the comparative cosmetic composition in terms of transfer resistance. The claimed cosmetic foundation composition was given a transfer resistance score of 3.5. The cosmetic foundation composition in accordance with *Suzuki* was given a score of 0.5. Accordingly, the claimed cosmetic composition exhibits a much higher transfer resistance than does the comparative cosmetic composition. (¶ 11.)

To reiterate, *Suzuki* discloses (meth)acrylic acid as an optional component, among others, in the skeleton of its graft copolymers. Moreover, *Suzuki* is silent as to the effect of these optional components on the properties of the graft copolymers, for example transfer resistance. In light of this silence, a person of ordinary skill in the art would not have expected the addition of (meth)acrylic acid would have a significant impact on the overall properties of the graft copolymers. (Pascal Declaration, ¶ 12.)

In sum, as shown in the Declaration, when a claimed cosmetic composition is directly compared to a cosmetic composition in accordance with *Suzuki's* teachings, the claimed cosmetic composition exhibits a 7-fold increase in transfer resistance. (*Id.*, ¶ 11.) It is submitted that these unexpected results establish that the claimed invention is nonobvious and patentable. Accordingly, reconsideration and withdrawal of the

rejection are respectfully requested.

Claims 1-4 and 6-24 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Torgerson, et al., WO 93/23446 ("*Torgerson*") as evidenced by Mougin, et al., U.S. Patent 5,851,517 ("*Mougin*"). (Paper No. 20080910 at 5.) Applicant respectfully traverses. The compositions taught by *Torgerson* are more remote from the claimed compositions than are those taught by *Suzuki*. The results set forth in the accompanying Declaration demonstrate the nonobviousness of the claimed compositions when compared to closer prior art than *Torgerson*. Accordingly, the unexpected results also establish that the claimed invention is nonobvious and patentable over *Torgerson* as evidenced by *Mougin*.

In making the rejection, the Examiner alleged that *Torgerson* discloses "a cosmetic composition comprising adhesive agents which are polysiloxane grafted polymers made by polymerization of polysiloxane containing monomers and non polysiloxane containing monomers" (Paper No. 20080910 at 5.) The Examiner also alleged that "non-polysiloxane monomers . . . can be selected from A and B monomers. A monomers . . . include n-butyl methacrylate, isobutyl methacrylate, t-butyl methacrylate, 2-ethylhexyl methacrylate, methyl methacrylate, etc, while B monomers include acrylic acid, methacrylic acid, hydroxyethyl methacrylate, etc." (*Id.* (citations omitted).) The Examiner further alleged that "the polysiloxane grafted polymers . . . [may be] dispersible in nonpolar solvents, such as cyclomethicone" (*Id.*) The Examiner has "relied upon *Mougin* to clarify that the silicone solvents (such as cyclomethicone or polydimethylsiloxane, etc) taught by [*Torgerson*] inherently have the global solubility parameter according to the Hansen solubility space of less than or equal to 17 (MPa)^{1/2}." (*Id.* at 10.)

Torgerson discloses 2 specific examples of the copolymers used in its compositions. One is a copolymer of t-butyl acrylate, acrylic acid, and polydimethylsiloxane (Experimental A). (P. 30, line 22 - p. 31, line 3.) The other is copolymer of t-butyl acrylate and polydimethylsiloxane (Experimental B). (P. 31, lines 4-24.) Both are produced as dry compounds. The copolymers are used in various exemplary compositions. (See Examples I-XI (P. 31, line 25 - p.36, line 23.) Only 2 of these examples include non-aqueous, silicone compounds (Examples IX and X). Examples IX and X are hair styling/conditioner compositions containing the copolymer of Experimental B. (P. 34, line 24.) The silicone compounds are octamethyl cyclotetrasiloxane and decamethyl cyclopentasiloxane. (P. 34, lines 25-26.) The copolymer, the silicone compounds, and butyl stearate, are combined to form a "Styling Polymer Premix," which is later mixed with other ingredients, including a significant amount of water, to form the final composition. (P. 34, lines 23-27 and p. 35, lines 14-16.)

Thus, the only combination of the copolymer and a non-aqueous, silicone compound medium disclosed by *Torgerson* is the styling polymer premix of Examples IX and X, before its combination with the other ingredients in the styling/conditioner compositions. The polymer in this premix is based on t-butyl acrylate without (meth)acrylic acid and there is nothing in *Torgerson* that discloses or suggests that the premix is a dispersion of polymer particles. The claims, on the other hand, recite cosmetic compositions containing dispersions of polymer particles, in which the polymer skeleton is based on C_1-C_3 (meth)acrylate and (meth)acrylic acid. Moreover, *Torgerson's* t-butyl acrylate is a C_4 acrylate, and thus, is not the claimed C_1-C_3 (meth)acrylate.

The comparative composition tested in the Declaration, includes a polymer based on methyl acrylate (*i.e.*, a C_1-C_3

(meth)acrylate) and monomethacryloyloxypropyl polydimethylsiloxane dispersed as a particle in decamethylcyclopentasiloxane. (Pascal Declaration, ¶ 4 and Lion Declaration, ¶¶ 3-5.) Therefore, the comparative composition is closer to the claimed compositions than the compositions disclosed in *Torgerson*, which contain a polymer based on a C₄ acrylate, i.e., t-butyl acrylate. Accordingly, the comparison described in the Declaration is a closer comparison than if the claimed composition had been compared to the compositions taught in *Torgerson*. Thus, the comparative results are equally or even more probative of nonobviousness over *Torgerson*:

Applicants **may compare the claimed invention with prior art that is more closely related to the invention than the prior art relied upon by the examiner.** *In re Holladay*, 584 F.2d 384, 199 USPQ 516 (CCPA 1978); *Ex parte Humber*, 217 USPQ 265 (Bd. App. 1961) (Claims to a 13-chloro substituted compound were rejected as obvious over nonchlorinated analogs of the claimed compound. Evidence showing unexpected results for the claimed compound as compared with the 9-, 12-, and 14- chloro derivatives of the compound rebutted the *prima facie* case of obviousness because the compounds compared against were closer to the claimed invention than the prior art relied upon.).

(M.P.E.P. § 716.02(e) (p. 700-296 (emphasis added)).)

As discussed above, when the claimed cosmetic composition is directly compared to a cosmetic composition in accordance with *Suzuki's* teachings (i.e., closer prior art than *Torgerson*) the claimed cosmetic composition exhibits a 7-fold increase in transfer resistance. (Declaration, ¶ 11.) Such results were unexpected. (*Id.*, ¶ 12.) Thus, it is submitted that these unexpected results also establish that the claimed invention is nonobvious and patentable over *Torgerson* in view of *Mougin*. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

In light of the foregoing, Applicant submits that the

presently claimed invention defines a patentable contribution to the art. As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. In the event the Examiner decides otherwise, supervisory review is respectfully requested.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that she telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which she might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By 

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